d) combining the identifier and the command into the instruction.

55. The method as set forth in claim 52 wherein transmitting the instruction to the safes comprises the steps of:
    a) conditioning the instruction for modulating a radio signal having a frequency in the range of 450 Megahertz to 470 Megahertz; and
    b) transmitting the modulated radio signal to the safes from an antenna, the transmitted radio signal having an output power in the range of 5 to 30 watts.

56. The method as set forth in claim 55 wherein enabling or disabling the particular safe lock mechanism comprises the steps of:
    a) receiving the transmitted radio signal;
    b) demodulating the instruction from the radio signal;
    c) reading the command contained in the instruction; and
    d) enabling or disabling the lock mechanism of the particular safe if the instruction contains the identifier specific to that safe.

REMARKS – General

An interview with the joint inventors has confirmed that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made.

Communications with the inventors have indicated that the invention is now in commercial use in three large hotels in Las Vegas, Honolulu, and on the big island of Hawaii. In every case the technology was not available from any other source.

The Specification has been amended editorially.

Claims 1-8, 10-20, and 22-28 have been cancelled, and rewritten as Claims 31-56 to more particularly define the invention in a patentable manner over the cited prior art.

Claims 9, 21, 29 and 30 are cancelled.

The Rejection of Claim 1 On Leonaggeo, et al. is Overcome

The last Office Action rejected independent claim 1 as being anticipated by U.S. 5,646,605 (Leonaggeo, et al). Claim 1 has been rewritten as claim 31 to define patentably over this reference. Applicants request reconsideration of this rejection, as now applicable to claim 31, for the following reasons:

1. Claim 31 recites novel features not present in the reference
2. The present invention solves a problem that was not previously recognized in the prior art
3. The prior art lacks any suggestion that the reference should be modified in a manner required to meet the claims of the present invention
4. If the present invention were obvious, because of its advantages, those skilled in the art would have implemented it by now.

Leonaggeo has a system for locking and unlocking a container from a remote location (see Col. 7, lines 46 – 52). The present invention is a system for remotely enabling or disabling the lock mechanism on a container.

Claim 1, now rewritten as Claim 31, teaches a "Means for inputting a command to **enable or disable the particular container lock mechanism**". This language distinguishes over Leonaggeo under Section 102 because Leonaggeo does not show a means of enabling or disabling the mechanism, but only a means to lock or unlock the lock.

This distinction is submitted to be of patentable merit under Section 103 because Leonaggeo lacks any suggestion that the lock should be enabled or disabled by remote control, rather it is only to be locked or unlocked. The invention described in the present application also solves a problem not addressed in the prior art, which is the security risk of having a locking mechanism on a safe that can be unlocked from a remote location, or by anyone who uses the telephone in the hotel room, such as hotel staff or someone who has gained illegal access to the room. The present invention shows a new principle of application for the remote control of locking mechanisms, in which the control of the lock can be activated by a telephone call, and at the same time the use of the locking container can be monitored for billing purposes. Although the advantage of such a system is inherent, it has not been appreciated in the prior art. The invention

of the present application is the only one of its kind now commercially available. Finally, the invention of Leonaggeo solves a different problem, which is to control many locks with one command, or to lock and unlock locks remotely. The purpose of the present invention is to give, from a remote location, the control of a lock to an individual, and to keep track of the amount of time the individual uses the lock.

The Rejection of Claim 10 Over Leonaggeo in view of del Castillo is Overcome

The last Office Action rejected independent Claim 10 under 35 U.S.C. 103(a) as being anticipated by U. S. Patent No. 5,646,605 (Leonaggeo, et al) in view of U. S. Patent No. 6,275.166 (del Castillo). Leonaggeo shows a method and apparatus for remotely locking and unlocking lock devices (see Col. 7, lines 46-52). Del Castillo teaches an RF remote appliance control and monitoring system for a hotel or a motel (Col. 4, lines 59-61).

Claim 10, now rewritten as Claim 39, teaches "means for inputting a command to **enable or disable a particular safe locking mechanism**" This claim distinguishes over the prior art for the same reasons given for former Claim 1, now Claim 31. Also, it is maintained that even if Leonaggeo and del Castillo were combined, modifications would be required to show all the features of Claim 39. Claim 39 teaches "each safe comprising safe control means for receiving the transmitted instruction and for **enabling or disabling the lock mechanism** of that safe if the instruction contains the identifier specific to that safe". The combination of Leonaggeo and del Castillo would require further modification to give the hotel customer the ability to open and close the safe using his own access code. Furthermore, the combination of Leonaggeo and del Castillo would not protect the customer from having anyone with telephone access in the room open the safe by making a telephone call.

The Rejection of Claim 22 Over Leonaggeo is Overcome

The last Office Action rejected independent Claim 22 as being anticipated by U.S. 5,646,605 (Leonaggeo, et al) under 35 USC 102(b). Leonaggeo shows a method and apparatus for remote control of lock devices that include input means for inputting a command to lock or unlock a particular lock device 105 (see Col. 7, lines 46-52).

Claim 22, now rewritten as Claim 50, recites "enabling or disabling the lock mechanism of the particular container". This language distinguishes over Leonaggeo under Section 102 because Leonaggeo does not show a means of enabling or disabling the mechanism, but only a means to lock or unlock the lock.

This distinction is submitted to be of patentable merit under Section 103 because Leonaggeo lacks any suggestion that the lock should be enabled or disabled by remote control, rather it is only to be locked or unlocked, and for the same reasons as given for Claim 1, now rewritten as Claim 31.

Dependent Claims Are Patentable Over Leonaggeo

New dependent claims 32-38 incorporate all the subject matter of claim 31 which makes them independently patentable over Leonaggeo.

Regarding dependent claims 32-37, applicants are simply describing standard radio/pager methods, which are not owned by anyone, and which more particularly describe the invention. Claim 38 describes another embodiment of the invention.

Dependent Claims Are Patentable Over Leonaggeo in View of del Castillo

New dependent claims 40-49 incorporate all the subject matter of claim 39 which makes them independently patentable over Leonaggeo in view of del Castillo.

Regarding dependent claims 43-48, applicants are simply describing standard radio/pager methods, which are not owned by anyone, and which more particularly describe the invention. Claim 49 describes another embodiment of the invention.

Leonaggeo, del Castillo and Biggs Cannot be Combined

The last Office Action rejected claims 12, 13, 25 and 26 over Leonaggeo in view of del Castillo and further in view of U.S. Patent 5,475,740 (Biggs, et al). Biggs teaches a system for enabling user access to and payment for amenities, such as pay-per-view, in a hotel using a telephone. The combination of Leonaggeo's remote locking mechanism with Bigg's system for enabling user access using the telephone is impossible without modifying Leonaggeo's mechanism in a

way that was never suggested by Leonaggeo. However, even if the combination could be made, new claims 53 and 54 distinguish because the combination does not show " interpreting the telephone call to the predetermined telephone number as a command to enable or disable the particular safe lock mechanism" . This distinction is patentable under Section 103 because Leonaggeo, del Castillo and Biggs lack any suggestion that modifications should be made in a manner that would meet the claims of the present invention. None of the references have suggested that the locking mechanism of a safe should be enabled or disabled using a telephone signal. Although the advantage of the present invention is inherent, those skilled in the art have not appreciated its advantage. The present invention is the only one of its kind commercially available.

Conclusion

For all of the reasons given above, it is respectfully submitted that the specification has been corrected editorially, the claims are now in proper form, and that the claim(s) all define patentability over the prior art under Section 102 because no prior art reference has claimed a system by which locking mechanisms can be enabled or disabled by remote means, and the claimed distinctions are of patentable merit under Section 103 because of the new results of a system that can be used for in-room hotel safes, the locking mechanisms of which can be remotely enabled and disabled, and monitored for use. Therefore it is submitted that this application is now in full condition for allowance, which action is respectfully solicited.

Respectfully Submitted,

Diane Kneeland

Diane Kneeland

Reg. No. 42749

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on December 14, 2004.

December 14, 2004 _____ *Diane Kneeland* _____

Diane Kneeland, Patent Agent

Application Number: 10/060,017   Application Filed: 01/28/2002

Applicants: Nick Ernst, Ian Kenneth Soutar, Clifford Edmund Haslam

Title: Automated Remote Control System for Hotel In-Room Safes

Examiner: Clara I. Yang   GAU: 2635